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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/912,099	07/24/2001	Zuoxing Yu	CSA 2 0145	5530

7590

08/27/2002

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EXAMINER

AHMED, SHEEBA

ART UNIT

PAPER NUMBER

1773

DATE MAILED: 08/27/2002

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Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/912,099

Applicant(s)

YU ET AL.

Examiner

Sheeba Ahmed

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☐ Claim(s) 1-29 is/are pending in the application.
- 4a) Of the above claim(s) 1-20 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☐ Claim(s) 21-29 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 5.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

**DETAILED ACTION**

***Election/Restrictions***

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:
  - I. Claims 1-20, drawn to a method of forming a composite, classified in class 264, subclass 171.1.
  - II. Claims 21-29, drawn to a composite, classified in class 428, subclass 515.

The inventions are distinct, each from the other because of the following reasons:

Inventions I and II are related as process of making and product made. The inventions are distinct if either or both of the following can be shown: (1) that the process as claimed can be used to make other and materially different product or (2) that the product as claimed can be made by another and materially different process (MPEP § 806.05(f)). In the instant case, the product can be made by a process other than extrusion. For example, the thermoplastic decorative layer could be solution casted on the elastomer rubber main body or the two layers may be adhesively bonded.

Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper.

During a telephone conversation with Mark Bandy on August 19, 2002, a provisional election was made with traverse to prosecute the invention of Group II, claims 21-29. Affirmation of this election must be made by applicant in replying to this Office action. Claims 1-20 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

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Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in-

(1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effect under this subsection of a national application published under section 122(b) only if the international application designating the United States was published under Article 21(2)(a) of such treaty in the English language; or

(2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that a patent shall not be deemed filed in the United States for the purposes of this subsection based on the filing of an international application filed under the treaty defined in section 351(a).

2. Claims 21 and 24-29 are rejected under 35 U.S.C. 102(e) as being anticipated by Honda et al. (US 6,110,546).

Honda et al. disclose an automobile weather strip (***corresponding to the wear resistant composite of claim 21***) that includes a weather strip body (***corresponding to the main body member of claim 21***) formed from a rubber composition and a decorative layer (***corresponding to the abrasion resistant decorative layer of claim 21***) comprising at least one thermoplastic elastomer directly adhered to the weather strip body (Column 1, lines 6-13). The rubber composition that forms the weather strip

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body comprises a rubber polymer such as an ethylene-alpha-olefin-non-conjugated diene copolymer (EODM) (***thus meeting the limitation that the main body member comprises a crosslinked elastomer rubber***) wherein the alpha-olefin maybe propylene (*in which case the EODM is EPDM*) (Column 3, lines 2-42). The decorative layer comprises a thermoplastic elastomer such as an olefin thermoplastic elastomer (TPO) or a styrene thermoplastic elastomer (TPS). The TPO comprises an ethylene-alpha-olefin copolymer rubber (***thus meeting the limitation that the decorative layer comprises an ethylene-alpha-olefin copolymer***) wherein the alpha-olefin may be octene (Column 3, lines 60-68 and Column 4, lines 11-32). The ethylene-alpha-olefin copolymer rubber can have a partially-crosslinked structure wherein the crosslinking is achieved via the use of crosslinking agents (Column 4, lines 63-68 and Column 5, lines 1-5). The styrene thermoplastic elastomer used in the decorative layer comprises an olefin resin and a vinyl aromatic compound such as styrene (Column 5, lines 6-20). The Examples indicate that the decorative layer may have a thickness of 0.3mm (***thus meeting the limitations of claims 27 and 28***). With regards to the process limitations recited in claims 26 and 29, the Examiner would like to remind the Applicants that the determination of patentability for product claims containing process limitations is based on the product itself and not on the method of production. If the product is the same or obvious from a product of the prior art, the claim is unpatentable even though the prior product was made by a different process. *In re Thorpe*, 227 USPQ 964, 966 (Fed. Cir. 1985) and also see MPEP 2113. In this case, the product (i.e., the composite material)

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is the same despite the process limitations of extruding the two layers together. All limitations of the claimed invention are disclosed in the above reference.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 22 and 23 are rejected under 35 U.S.C. 103(a) as being unpatentable over Honda et al. (US 6,110,546) in view of Scott et al. (US 3,654,155).

Honda et al., as discussed above, state that the decorative layer may comprise a ethylene-octene copolymer which has been at least partially crosslinked but do not specifically state that ethylene-octene copolymer rubber used in the decorative layer is crosslinked with a silane compound. However, Scott et al. the crosslinking of olefin copolymer using a silane compound such that the crosslinking may be carried out in two stages and yields a product that has extremely high resistance to stress cracking and could be employed in extruded articles (Column 1, lines 54-65 and Column 5, lines 14-26). Accordingly, it would have been obvious to one having ordinary skill in the art to crosslink the ethylene-octene copolymer disclosed by Honda et al. with a silane compound given that Scott et al. specifically teach that doing so yields a product that has extremely high resistance to stress cracking and could be employed in extruded articles.

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**Conclusion**

4. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Sheeba Ahmed whose telephone number is (703)305-0594. The examiner can normally be reached on Mon-Fri 8am-4pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Paul Thibodeau can be reached on (703)308-2367. The fax phone numbers for the organization where this application or proceeding is assigned are (703)305-5408 for regular communications and (703)305-3599 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703)306-5665.



Sheeba Ahmed  
August 21, 2002



Paul Thibodeau  
Supervisory Patent Examiner  
Technology Center 1700